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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,125	10/12/2001	Carol Stonebrook Lachance	LD30/01	2412

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EXAMINER

SCHOPFER, KENNETH G

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 06/03/2003

07

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/977,125

Applicant(s)

LACHANCE, CAROL
STONEBROOK

Examiner

Kenneth G Schopfer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2 and 5-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen (USPN 5507794).

5. Referring to claim 2, Allen teaches all of the limitations of this claim except for the ice patch and jacket being disc shaped, the ice patch being made of plastic-vinyl material, and the decorative indicia coupled to the exterior panel of the jacket. Allen teaches an ice patch 40 made of a plastic film envelope with a freezable gel inside (column 4, lines 9-25) and a jacket 20

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composed of natural or synthetic cloth having a pocket on the upper one-third of the jacket for receiving the ice patch (column 3, lines 55-60). Also, Allen teaches a support member 10 for carrying the pouches and applying them to a user. Further, it is well known in the art to use decorative indicia on the surface of an ice pack to make the pack more aesthetically appealing to a user, especially a child. It would have been obvious to one of ordinary skill in the art at the time of invention that the use of a circular shaped patch with a diameter of 3.5 inches, plastic-vinyl material, and decorative indicia as in the claims represent unpatentable design choices over the ice patch and jacket of Allen that would not change the ability of the device to provide therapeutic cooling to a user.

6. Referring to claim 5, Allen teaches all of the limitations of this claim as described above except for the indicia on one surface of the ice patch. It would have been obvious to one of ordinary skill in the art at the time of invention that the use of indicia on the ice patch as in the claims represents an unpatentable design choice over the ice patch of Allen that would not change the functionality of the device.

7. Referring to claim 6, Allen teaches all of the limitations of this claim as described above except for the jacket being made of Pellon. It would have been obvious to one of ordinary skill in the art at the time of invention that the use of Pellon as in the claims represents an unpatentable design choice over the use of the cloth in Allen that would not change the functionality of the device.

8. Referring to claims 7-13, Allen teaches all of the limitations of these claims as described above except for the decorative indicia on the jacket. It would have been obvious to one of ordinary skill in the art at the time of invention that the use of decorative indicia including a

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teddy bear, volley ball, tennis ball, hockey stick, baseball, flower, and lady bug as in the claims represents an unpatentable design choice over the jacket of Allen that would not change the functionality of the device.

9. Claims 1, 3, and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen (USPN 5507794) in view of Thomas et al. (USPN 5215080).

10. Referring to claim 1, Allen teaches all of the limitations of this claim except the ice patch and jacket being disc shaped; the ice patch being made of plastic-vinyl material; the decorative indicia coupled to the exterior panel of the jacket; the carrying case; and the tie. Allen teaches an ice patch 40 made of a plastic film envelope with a freezable gel inside (column 4, lines 9-25) and a jacket 20 composed of natural or synthetic cloth having a pocket for receiving the ice patch (column 3, lines 55-60). Also, Allen teaches a support member 10 for carrying the pouches and applying them to a user. Further, it is well known in the art to use decorative indicia on the surface of an ice pack to make the pack more aesthetically appealing to a user, especially a child. It would have been obvious to one of ordinary skill in the art at the time of invention that the use of a circular shape, plastic-vinyl material, and decorative indicia as in the claims represent unpatentable design choices over the ice patch and jacket of Allen that would not change the ability of the device to provide therapeutic cooling to a user.

Thomas et al. teach a therapeutic cold pack system including a carrying case for carrying ice packs made of a heavy cloth material with front and back walls where the back wall extends into a flap for closing the case. Also, stitching and hook and loop fastening strips form two pockets in the case for holding two ice packs. It would have been obvious to one of ordinary skill in the art at the time of invention to use a carrying case as in Thomas et al. with the device

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of Allen to provide a suitable means for transporting the device and attaching the device to a user. Further, it would have been obvious to one of ordinary skill in the art at the time of invention that the use of a tie to close the carrying case as in the claims represents an unpatentable design choice over the hook and loop strips in the combined device of Allen and Thomas et al. that would not change the functionality of the device.

11. Referring to claim 3, Allen teaches all of the limitations of this claim as described above except for the carrying case. Thomas et al. teach a therapeutic cold pack system including a carrying case for carrying ice packs made of a heavy cloth material with front and back walls where the back wall extends into a flap for closing the case. Also, stitching and hook and loop fastening strips form two pockets in the case for holding two ice packs. It would have been obvious to one of ordinary skill in the art at the time of invention to use a carrying case as in Thomas et al. with the device of Allen to provide a suitable means for transporting the device and attaching the device to a user.

12. Referring to claim 4, Allen and Thomas et al. teach all of the limitations of this claim as described above except for the tie for closing the device. It would have been obvious to one of ordinary skill in the art at the time of invention that the use of a tie to close the carrying case as in the claims represents an unpatentable design choice over the hook and loop strips in the combined device of Allen and Thomas et al. that would not change the functionality of the device.

Response to Arguments

13. Applicant's arguments filed March 11, 2003 have been fully considered but they are not persuasive.

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14. The applicant argues that the first office action dismissed claim limitations that are essential to the functionality of the device on a patient's eye including the stitching on "the lower two-thirds of the jacket... with the upper one-third forming an opening" and the "indicia coupled to the exterior panel of the jacket." It is clear that the ice packs of Allen include a jacket with an opening in the upper one-third and some stitching in the lower two-thirds to hold the fabric together and that the device could have been used effectively over the eyes of a patient whether or not it is modified to a circular shape. Further, the prior art of record clearly show that it is quite common in the art to make ice packs with aesthetically appealing indicia on an outer surface in order for the device to be more attractive to a user, and that these indicia do not enhance the functionality of these devices.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth G Schopfer whose telephone number is 703-305-2649.

The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on 703-308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

KS

KS

May 20, 2003



LINDA C. M. DVORAK
SUPERVISORY PATENT EXAMINER
GROUP 3700